

U.S. Serial No. 10/801,350
Amendment Dated May 23, 2005
Response To Office Action Dated February 22, 2005

REMARKS

The pending application was filed on March 16, 2004 with claims 1-35. The Examiner issued a Restriction Requirement dated November 18, 2004 identifying claims 1-30 as Group 1 and claims 31-35 as Group 2. A response was filed on December 6, 2004 in which claims 1-30 were elected. The Examiner issued a Non-Final Office Action dated February 22, 2005 in which the Examiner objected to claim 20 over informalities and rejected claims 1-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The Examiner also rejected claims 1-5, 7, 10, 11, 14-16 under 35 U.S.C. §103(a) as being unpatentable over United States Published Patent No. 2003/0024150 to *Hawkins* in view of United States Patent No. 5,220,743 to *McClellan*, claims 6-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* further in view of United States Patent No. 5,070,639 to *Pippert*, claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* further in view of United States Patent No. 6,240,672 to *Huppert*, claims 12, 17-22, 27, 28, 29, and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* and other prior art, and claims 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* and further in view of other prior art and *Pippert*.

Claims 1-30 are pending in the patent application. Claims 31-35 have been previously withdrawn. Claims 1, 17, and 30 have been amended. In view of the arguments set forth

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below, claims 1-30 are allowable, and the Examiner is respectfully requested to withdraw the rejections and issue a timely Notice of Allowance.

I. CLAIM OBJECTIONS

The Examiner objected to claim 20 because the Examiner stated that there are two claims having the number 20. The Examiner suggested that the second of the two claims be renumbered claim 30. The second of the two claims numbered 20 has been amended to be numbered claim 30, as suggested by the Examiner. Therefore, the Examiner is respectfully requested to withdraw the rejection.

II. CLAIMS 1-30 REJECTED UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner rejected claims 1-30 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. The Examiner stated that claim 1 ends with a semi-colon and suggested that the semi-colon be replaced with a period. Claim 1 has been amended in accordance with the Examiner's suggestion. The Examiner also stated that claim 17 includes language that renders the claim indefinite because the hook is compared to itself. Claim 17 has been amended such that the "weight [is] coupled to the hook along a shank of the hook" Thus, claims 1 and 17 have been amended to overcome the rejection, and the Examiner is respectfully requested to withdraw the rejections.

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III. REJECTION OF CLAIMS 1-30 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 1-5, 7, 10, 11, 14-16 under 35 U.S.C. §103(a) as being unpatentable over United States Published Patent No. 2003/0024150 to *Hawkins* in view of United States Patent No. 5,220,743 to *McClellan*. Specifically, the Examiner stated that *Hawkins* discloses a body having at least one cavity in a midsection of the body and at least one opening in a top surface of the body. The Examiner also stated that *McClellan* discloses a fishing lure having a weight mounted on a fishing hook closer to the throat of the hook than the line receiving portion of the hook. The Examiner stated that it would have been obvious to provide *Hawkins* with a weight mounted hook as shown by *McClellan* to change the action of the lure in the water.

Claim 1 has been amended to state in relevant part "a body having at least one cavity in a midsection of the body for receiving a weight, a shank receiving cavity extending between the at least one cavity in the midsection of the body and a nose of the body, and at least one opening in a top surface of body." In stark contrast, *Hawkins* does not disclose at least one cavity in a midsection of the body for receiving a weight. Rather, *Hawkins* discloses a cavity extending through the body to the nose of the body. Furthermore, *Hawkins* does not disclose a "a shank receiving cavity extending between the at least one cavity in the midsection of the body and a nose of the body." Rather, *Hawkins* discloses a single cavity configured to contain a weight attached to a hook at an eye of the hook. Moreover, *Hawkins*

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does not disclose a "hook having a weight . . . thereby positioning the weight proximate to a midpoint of the body." Positioning a weight within a lure as claimed is not disclosed in *Hawkins*, nor is such a lure disclosed in *McClellan*.

McClellan discloses a hook having a weight coupled to a shank of a hook. In addition, *McClellan* discloses use of the hook together with a lure. However, each embodiment disclosed in *McClellan* discloses the hook combined with the lure such that the point of the hook is buried within the lure and a helical coil proximate to the eye of the hook extends into the lure. *McClellan* does not disclose or suggest combining a hook with a weight as disclosed and positioning the weight hook within a lure body such that the weight is concealed within the lure. Rather, *McClellan* discloses a helical coil (16) to attach the hook to the lure such that the weight coupled to the hook is positioned outside of the lure. Such a configuration is drastically different than the claimed invention. The embodiments disclosed in *Hawkins* and *McClellan* produce drastically different actions in a lure in water. The combination of *Hawkins* and *McClellan* does not yield the action produced by the claimed invention. Thus, for at least these reasons, the claimed invention is not rendered obvious by the combination of *Hawkins* and *McClellan*, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claims 6-9 under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* further in view of United States Patent No. 5,070,639 to *Pippert*. The Examiner stated that *Hawkins* and *McClellan* disclose fishing lures as claimed,

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but the Examiner admitted that neither *Hawkins* nor *McClellan* disclose a body saving device coupled to the base. The Examiner stated that *Pippert* discloses a fishing lure having a body saving device coupled to the base. The Examiner concluded that it would have been obvious to provide the fishing lure of *Hawkins* as modified by *McClellan* with a body saving device as shown by *Pippert*. The Examiner also stated that while *Pippert* only discloses a single protrusion that multiple protrusions would have been obvious.

Paragraph 38 of the specification provides that "the body saving device 62 may be formed from one or more protrusions 62 for preventing the weight 34 from cutting through the body 12 when the body 12 impacts a piling, rock pile, limb, or other resilient structure." In sharp contrast, the protrusion disclosed in *Pippert* is defined as a barb in *Pippert*. A barb would not act as a body saving device in a lure. Rather, a barb would damage a lure upon impact with a piling, rock pile, limb, or other resilient structure. Thus, the combination of *Pippert* with *Hawkins* and *McClellan* does not render the claims 6-9 obvious, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* further in view of United States Patent No. 6,240,672 to *Huppert*. The Examiner stated that *Hawkins* and *McClellan* disclose the claimed invention but do not show a plurality of ribs extending around the body. The Examiner stated that *Huppert* discloses a fishing lure having a plurality of ribs extending around the body. The

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Examiner concluded that it would have been obvious to provide the lure of *Hawkins* as modified by *McClellan* with a plurality of ribs.

Claim 13 depends directly from claim 1, which is allowable for the reasons previously set forth. Thus, claim 13 is allowable, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claims 12, 17-22, 27, 28, 29, and 30 under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* and other prior art. The Examiner stated that *Hawkins* as modified by *McClellan* disclose the claimed invention, but the Examiner admitted that neither *Hawkins* nor *McClellan* discloses a plurality of legs extending from the head. The Examiner concluded that it would have been obvious to provide the lure of *Hawkins* as modified by *McClellan* with a plurality of legs as shown by the admitted prior art of figures 1-2 for the purposes of making the lure resemble a shrimp.

Claim 17 of the pending application is directed in part to "an elongated body configured to resemble a shrimp and having at least one cavity in a midsection of the body, a head, a tail, and a plurality of legs extending from the head." In addition, claim 12 states "wherein the body includes a head at a first end, a tail at a second end generally opposite to the first end, and at least one set of legs extending from the head." In contrast, neither *Hawkins* nor *McClellan* discloses a lure having a body configured to resemble a shrimp. Furthermore, there is no motivation disclosed in *Hawkins* or *McClellan* to combine the

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elements disclosed in these references with a lure resembling a shrimp. Such a conclusion is impermissible hindsight.

The lure disclosed in *Hawkins* exhibits action in water that resembles a particular baitfish. The hook disclosed in *McClellan* causes a lure to exhibit a different action. However, the combination of *Hawkins* and *McClellan* does not produce the action capable of being produced by the claimed invention. For instance, neither reference discloses a shrimp body. Neither reference discloses a weight positioned within a cavity, where the "weight is positioned closer to a throat of the hook than to a line receiving portion of the hook." Such a claimed lure presents a completely different action than a hook with a weight attached to the shank, wherein the weight is positioned outside of the lure body, as disclosed in *McClellan*. A conclusion that a combination of the elements disclosed in *Hawkins* with elements disclosed in *McClellan* together with prior art does not render the claimed invention, and is impermissible hindsight. Thus, for at least these reasons, claim 12 and 17 and those claims depending from claim 17 are allowable, and the Examiner is respectfully requested to withdraw the rejection.

As concerning claim 28, neither *Hawkins* nor *McClellan* discloses a shank containing region "sized to allow a shank of the hook to be inserted into the shank containing region but to restrict the weight from being inserted into the shank containing region." Rather, *Hawkins* discloses a cavity large enough to enable a weight to be inserted from the opening to the head of the lure, without restricting the weight, and *McClellan* does not disclose such a shank

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containing region in a lure either. In addition, claim 28 is allowable for the reasons previously set forth. Thus, claim 28 is allowable for at least these reasons, and the Examiner is respectfully requested to withdraw the rejection.

As concerning claim 30, neither *Hawkins* nor *McClellan* discloses a fishing lure "wherein the weight is positioned in the body such that a midpoint of the weight is in a midsection of the body." *McClellan* discloses attaching a hook and weight combination to a lure. However, *McClellan* does not disclose attaching the hook such that the weight is positioned within a cavity in the lure and in a midsection of the body. Rather, *McClellan* discloses attaching a weight to a hook and positioning it outside of a lure body. Equally distant from the claimed invention is the teaching of *Hawkins*, which discloses a hook having a weight positioned within a cavity at the head of the lure. Neither reference, taken individually or collectively, discloses the claimed invention. In addition, claim 30 depends from allowable claim 17. Thus, for at least these reasons, claim 30 is allowable, and the Examiner is requested to withdraw the rejection.

Claims 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hawkins* in view of *McClellan* and further in view of other prior art and *Pippert*. The Examiner stated that it would have been obvious to provide the lure of *Hawkins* as modified by *McClellan* and prior art with a body saving device shown in *Pippert*.

Paragraph 38 of the specification provides that "the body saving device 62 may be formed from one or more protrusions 62 for preventing the weight 34 from cutting through

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the body 12 when the body 12 impacts a piling, rock pile, limb, or other resilient structure."

In sharp contrast, the protrusion disclosed in *Pippert* is defined as a barb in *Pippert*. A barb would not act as a body saving device in a lure. Rather, a barb would damage a lure upon impact with a piling, rock pile, limb, or other resilient structure. Thus, the combination of *Pippert* with *Hawkins* and *McClellan* does not render the claims 23-26 obvious, and the Examiner is respectfully requested to withdraw the rejection.

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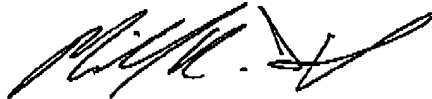
CONCLUSION

For at least the reasons given above, claims 1-30 define patentable subject matter and are thus allowable. The undersigned representative thanks the Examiner for examining this application.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,



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